

Remarks and Arguments

Applicant has carefully considered the office action mailed December 13, 2005 and respectfully requests reexamination and reconsideration of this application.

Applicant has not amended the claims as part of this response and claims 20, 21, 23, 84, 85, 87, and 92 remain pending in the application with claims 20, 84 and 85 being independent claims.

Correction of Power of Attorney

The practitioners associated with customer number 021127 have been appointed, by the assignee, to prosecute this application. A copy of the Power of Attorney filed on January 22, 2002 is attached.

It has come to Applicant's attorneys' attention that, while the correspondence address for this application has been changed, the USPTO's PAIR information does not correctly list the attorney/agent information.

Applicant respectfully requests that the information in the PTO database be corrected to accurately reflect the practitioners associated with this application.

Rejections under 35 U.S.C. §103

According to the office action, claims 20, 21, 23, 84, 85, 87 and 92 stand rejected under §103 as being unpatentable over Glogau (WO 9825373) in view of Ginter (U.S. Patent 5,892,900). Applicant respectfully traverses this rejection as set forth hereafter.

The Examiner has failed to establish a prima facie case of obviousness.

The Applicant respectfully submits that the Examiner has failed to produce a prima facie case of obviousness. In accordance with MPEP §2142, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.

There are three basic criteria that must be met in order to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must

be a reasonable expectation of success. Third, the prior art references, when combined, must teach or suggest all of the claim limitations.

“The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.” (MPEP §2142) The Examiner “must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Finally, when the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. The Examiner “must explain with reasonable specificity at least one rejection, otherwise the Examiner procedurally fails to establish a prima facie case of obviousness.” (MPEP §2142)

As to the first part, Applicant submits that the Examiner has not explained, with reasonable specificity, where the motivation to combine Glogau and Ginter is to be found.

The Examiner has set forth, in this and previous office actions, that Glogau discloses a copy protection system/method that protects websites and other works in computer readable form from unauthorized access and/or reproduction. (Office action, page 2) The Examiner notes, however, that Glogau “fails to explicitly disclose” the step wherein the server security program distributes the contents to a client system if the client system has a limited-use client program and wherein the limited-use client program is a web browser program configured to disable non-ephemeral reproduction functions of the web browser program while the distributed content is detected.

The Examiner maintains that Ginter remedies the deficiencies of Glogau and states the following at page 3 of the current office action:

However, Ginter discloses a system/method for electronic commerce including secure transaction management and electronic rights protection. A virtual distribution environment (VDE) may be used to protect rights of various participants in electronic commerce. A secure processing unit (SPU) to help provide a high level of security for VDE (see., abstract, col 3-col 118). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the copy protection

method/system of Glogau by including the limitations detailed above as taught by Ginter because this would prevent from being illegally viewed or copied to thereby protect its copyright.

U.S. Patent 5,892,900 to Ginter includes 220 claims, 163 drawing sheets, 346 columns of specification (not including the claims) and, when printed, requires 360 pages.

The Examiner's entire explanation as to motivation to combine has been set forth above. Applicant submits that the Examiner's reference to the abstract and to 116 columns of disclosure does not rise to the level of "reasonable specificity" as to an explanation of motivation and, therefore, for at least this reason, fails to establish a prima facie case of obviousness.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. Applicant respectfully submits that a broad reference to 116 columns of a published patent application, especially by an Examiner that was involved in the examination of the application,¹ is not reasonably specific.

Further, Applicant respectfully submits that the combination of Glogau in view of Ginter does not teach or suggest all of the claim limitations of the pending claims.

As has been set forth above, the Examiner acknowledges that Glogau fails to explicitly disclose a limited-use client program that is a web browser configured to disable non-ephemeral reproductions of the web browser while the distributed content is detected as being displayed by the web browser program at the client system. Ginter does not disclose, and the Examiner has not pointed to such a disclosure, of a web browser program as recited in at least independent claims 20, 84 and 85.

Applicant notes that a text word search of Ginter results in no hits for the words: browser, netscape, navigator, "internet explorer," or hypertext. Applicant submits that the Examiner has used impermissible hindsight based upon Applicant's own disclosure

¹ Pierre Elisca is listed as the assistant examiner on the Ginter patent.

and the Examiner has failed to reach a prima facie legal conclusion as to obviousness based only on the facts found in the Glogau and Ginter references.

For at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness with respect to the pending claims, i.e., claims 20, 21, 23, 84, 85, 87 and 92.

Assuming, without agreeing, that the Examiner has set forth a prima facie case of obviousness, Applicant respectfully submits that the cited combination of Glogau in view of Ginter does not render obvious that which is recited in any of the claims.

Glogau is directed to a system for preventing unauthorized access and/or reproduction of copyrightable work that is available in a computer readable format. (Abstract). In operation, an owner or operator of a website where copyrighted material is available will configure its system such that only licensed or authorized users are able to access the protected material. (Page 5, lines 6-20). Glogau teaches that the website is modified by a copy protection system where the material available on the website is categorized as to whether or not only an authorized user is able to access the material. When a user accesses the website, a determination is made as to whether that particular end-user is licensed or authorized. This involves a process of checking for the presence of an indication, for example, a cookie on the end-user's system, as evidence of prior authorization. If the end-user is authorized, then access to the material is granted. (Page 12, line 6-page 13, line 1).

When the end-user wishes to obtain local copies of the protected material, and is authorized, the end-user downloads site copying software in order to complete the copying operation. (Page 29, lines 12-15).

In summary, Glogau teaches a system whereby an owner of copyright protected material controls access to the material. Once the protected material is identified, only authorized users are able to access the protected material. Glogau teaches that an end-user desiring access to the protected material must first become licensed and then, in order to copy the material, download a specific program.

Ginter is directed to systems and methods for electronic commerce that include secure transaction management and electronic rights protection. (Abstract) Ginter

describes a virtual distribution environment that is a secure system for regulating electronic conduct in commerce. Various parties, including content providers, electronic hardware manufacturers, financial service providers or electronic “infrastructure” companies such as cable or telecommunications companies insure regulation by putting control information in place. The control information implements a “rights application” that runs on a software base that serves as a secure, flexible, general purpose foundation to accommodate different rights applications. Various “building blocks” can be combined together to create electronic agreements to protect the rights and may enforce a fulfillment of obligations between users and providers.

Ginter discloses that the virtual distribution environment (VDE) normally employs an integration of cryptographic and other security technologies, e.g., encryption, digital signatures, etc., with other technologies. These other technologies include component, distributed, and event driven operating system technology, object container software, databases, smart agents, smart cards and semiconductor design technologies. In one embodiment, at least one secure hardware element, for example, a semiconductor element or other hardware module for securely executing virtual distribution environment control processes, is provided at nodes within the system. A secure processing unit (SPU) is described by Ginter as an integrated circuit chip 504 including hardware 506 and firmware 508. The SPU 500 connects to the rest of an electronic appliance through an “appliance link” 510.

In summary, Ginter describes a system for securely connecting and controlling transactions in a wide variety of fields to thereby control and limit access to only those parties that are authorized.

In order to render obvious that which is recited in the claims, the combination of Glogau in view of Ginter must teach or suggest all of the limitations of the claims. As set forth above, and in the prior responses to previous office actions, the claims include a web browser program configured to disable non-ephemeral reproduction functions while distributed or downloaded content is detected as being displayed by the web browser program at a client.

The Examiner acknowledges that Glogau fails to teach or suggest such a limitation. As has already been set forth above, Ginter is totally silent as to a web

browser program and its functionality. While there is a fleeting reference to the worldwide web protocol, i.e., html, http and URL, these references are only in one location and their references is with regard to the formatting of VDE objects only and not to the operation of a web browser program. Further, there is not teaching or suggestions as to disabling non-ephemeral reproduction when protected content is being displayed.

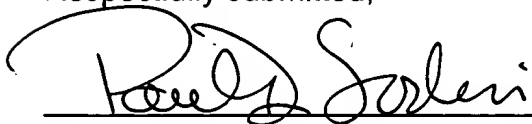
Applicant respectfully submits that any combination of Glogau in view of Ginter results in a system such as Glogau's that further controls access to material by incorporating, for example, the VDE and SPU teachings, such as a hardware device for confirming authorization access. The resulting combination of these references, however, does not result in that which is recited in Applicant's claims.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are not rendered obvious by the cited combination of references.

Applicant respectfully reasserts all the arguments and traversals set forth in prior responses to the extent still relevant to any outstanding rejections. If, after considering the above remarks, the Examiner is still of the opinion that allowable subject matter is claimed, Applicant respectfully requests a telephone interview with the Examiner and his supervisor to resolve any outstanding issues prior to issuance of any further office actions.

Applicant believes the claims are in allowable condition. A Notice of Allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this response, he is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.16 and 1.17 to Deposit Account No. 02-3038.

Respectfully submitted,



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